



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

X

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/758,957	01/11/2001	Robert N. Hanson	346715-0611	9648
48329	7590	03/10/2006	EXAMINER	
FOLEY & LARDNER LLP 111 HUNTINGTON AVENUE 26TH FLOOR BOSTON, MA 02199-7610			EPPERSON, JON D	
		ART UNIT		PAPER NUMBER
				1639

DATE MAILED: 03/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/758,957	HANSON ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jon D. Epperson	1639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 03 January 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 63-70 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 69 and 70 is/are allowed.
- 6) Claim(s) 63-66 and 68 is/are rejected.
- 7) Claim(s) 67 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All
  - b) Some \*
  - c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### *Request for Continued Examination (RCE)*

1. A request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection (e.g., see 1/3/06 Response). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/3/05 has been entered. Claims 15, 55, 56 and 58-62 were pending. Applicants canceled claims 1-62 and added claims 63-70. Therefore, claims 63-70 are pending and active in the instant application. An action on the merit follows.

Those sections of Title 35, US code, not included in the instant action can be found in previous office actions.

### Withdrawn Objections/Rejections

2. All previous rejections are withdrawn in view of Applicants' amendments and/or arguments.

### New Rejections

#### *Claim Rejections - 35 USC § 112*

3. Claims 63-66 and 68 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably

convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

The specification as originally filed does not provide support for the invention as now claimed. The specification as originally filed includes only two specific structures that would read on the presently claimed generic (i.e. Figure 9, bottom two compounds). This is deemed to be insufficient support for the newly recited generic that encompasses a wide variety of compounds outside of those compounds presented in Figure 9 (please note that generic formula II does not appear anywhere in the specification and/or the original set of claims). For example, none of the figures provide support for the ring structure wherein X = CH. Figure 10 shows the nitrogen atom adjacent to the ethylene group (i.e., -CH<sub>2</sub>CH<sub>2</sub>-NC<sub>5</sub>H<sub>9</sub>-CH(R)-CO<sub>2</sub>H), not the carboxylic acid as currently claimed (i.e., -CH<sub>2</sub>CH<sub>2</sub>-C<sub>5</sub>H<sub>9</sub>N-CH(R)-CO<sub>2</sub>H).

Furthermore, formula (II) recites substituted phenyl for R<sub>10</sub> and R<sub>11</sub>, but figure 9 provides just one example of a substitution (i.e., a “F” atom at the para position for ZHN-94, GBR 12935 is not substituted). Thus, the specification fails to provide support for the infinite number of substitutions that are currently claimed. For example, Applicants fail to provide any “identifying” language that would encompass the claimed genus (e.g., Applicants do not state in the specification that a “halogen” can be substituted at the *ortho*, *meta* and *para* positions). For example, in *In re Grimme, Keil, and Schmitz* 124 USPQ 499 (CCPA 1960) the Court held that naming one member of a chemical genus (i.e., a single species) is not, in itself, proper basis for a claim to an entire chemical genus unless the genus is sufficiently identified in the application by other appropriate language (e.g., see *In re Grimme, Keil and Schmitz* 124 USPQ 499, 501) (“On the other hand, in the case of a small and closely related group such as the halogens, the naming

Art Unit: 1639

of the group should ordinarily be sufficient since nothing of consequence would be added by also naming each of the well known members of the group"). Here, Applicants failed to "name the group" and thus do not provide any "identifying" language (e.g., halogen) that would support the claimed genus. Therefore, the disclosure of a single species (i.e., the "F" atom) in the *ortho*, *meta* and *para* positions of the phenyl rings fails to satisfy the test set forth in *In re Grimme, Keil and Schmitz*; see also *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1326, 56 USPQ2d 1481, 1486 (Fed. Cir. 2000) wherein the CAFC stated, "Ruschig [referring to *In re Ruschig* 379 F.2d 990, 154 USPQ 118 (CCPA 1967)] makes clear that one cannot disclose a forest in the original application, and then later pick a tree out of the forest and say "here is my invention." In order to satisfy the written description requirement, the blazemarks directing the skilled artisan to that tree must be in the originally filed disclosure.").

#### ***Allowable Subject Matter***

4. Claims 69 and 70 are allowed. Furthermore, claim 67 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon D Epperson whose telephone number is (571) 272-0808. The examiner can normally be reached Monday-Friday from 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (571) 272-0811. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

Art Unit: 1639

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jon D. Epperson, Ph.D.  
March 5, 2006

JON EPPERSON, PH.D.  
PATENT EXAMINER

A handwritten signature in black ink, appearing to read "JON D. EPPERSON".